

## REMARKS

### Drawings

A set of formal drawings was submitted on February 14, 2003 (date stamped February 21, 2003) to correct the informalities indicated in the Notice of Draftsperson's Patent Drawing Review.

### Status of the claims

Claims 15, 17-21, and 29-33 were pending. Claims 15, 17, 18, 20, 21, and 29-32 were rejected under 35 U.S.C. §102. Claims 19 and 33 are allowed.

By virtue of this amendment, claims 17 and 33 are cancelled and claims 15, 18, 19, 20, 29 and 32 are amended. Entry of the above amendments and reconsideration of the claims, as amended, are respectfully requested. Upon entry of these amendments, claims 15, 18-21, 29-32 will be pending.

The cancellation of the claims is not intended as a dedication to the public, of the subject matter thereof. Applicants reserve the right to pursue the subject matter of the cancelled claims in a continuation application. The claims have been amended in an effort to present them in condition for allowance or in better form for appeal. Specifically, Applicants have amended allowed claim 19 to convert it to an independent claim incorporating all the limitations of claim 15 from which claim 19 depends. Claim 15 has been amended to claim only the anti-PSCA antibodies produced by the specific ATCC deposited hybridomas recited in allowed claim 19 and disclosed in the specification on page 2 at lines 28-30. Claims 18, 20, 29 and 32 have been amended merely to correct the dependency upon the cancellation of other claims, or to add dependency to allowed claim 19. The composition of allowed claim 33 is now covered by amended claim 29.

Claims 15, 17-18, 20-21 and 29-32 were rejected under 35 U.S.C. §102(e) over Reiter et al. (WO 98/40403). Applicants submit that the amendment to independent claim 15 overcomes this rejection. Reiter et al. do not provide anti-PSCA antibodies produced by the ATCC deposited hybridomas recited in independent claim 15. It is respectfully requested that the sole rejection under 35 U.S.C. §102(e) be withdrawn.

The Advisory Action dated April 8, 2003 indicated that applicants' reply of February 24, 2002, has overcome the rejection under 35 U.S.C. §102(e). However the Advisory Action indicated that the proposed amendments raised new issues that would require further consideration and/or search. The Examiner also remarked that amended claims 15 and 19 appear to be identical in scope.

Applicants do not believe the claim amendments raise any new issues that would require further consideration or search for the following reasons. The Examiner has indicated in the final Office Action that claims 19 and 33 are allowed. Applicants have merely amended claim 19 to convert it to an independent claim incorporating all the limitations of claim 15 from which claim 19 depends. If the antibody of claim 19 and the composition of amended claim 29 [formerly covered in claim 33] comprising the antibody of claim 19 are allowed, the claims that depend from claims 19 and 29 should be allowed. With regard to claim 15, this claim as amended is limited to the anti-PSCA antibodies produced by the ATCC deposited hybridomas. Since claim 19 is allowed, there is no reason why amended claim 15 and its dependent claims should not be allowed. Applicants submit that claims 15 and 19 are not identical in scope; claim 15 is directed to anti-PSCA antibodies that are produced by the deposited hybridomas whereas claim 19 is directed to humanized forms of the antibodies of claim 15.

In view of the above amendments and remarks, Applicants believe the pending claims are allowable since the presently amended claims depend from allowed claims and recite further limitations; the amended claims do not require further searching.

#### **CONCLUSION**

Applicants submit that the above discussion is fully responsive to all grounds of rejection set forth in the Office Action. In view of the comments above, Applicants respectfully request that all outstanding rejections be withdrawn, and that the pending claims, as amended, be allowed. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 07-0630 (Ref. Docket No. P1777R1). However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,  
GENENTECH, INC.

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